

REMARKS

Claims 1-42 are pending in the application.

Restriction Requirement

Page 2 of the instant Office Action sets forth a requirement for restriction, pursuant to 35 U.S.C. §121, of the claims to one of the following invention groups:

- Group I: claims 1-14 (drawn to a mutant mammalian G protein coupled receptor; class 530, subclass 350);
- Group II: claims 15-39 (drawn to a yeast cell expressing a mutant mammalian G protein coupled receptor; class 435, subclass 254.2); and
- Group III: claims 40-42 (drawn to a method for identifying a modulator of a mammalian G protein coupled receptor; class 435, subclass 7.2);

Applicants respectfully traverse the requirement for restriction because Applicants believe that the restriction requirement is improper on a number of grounds.

First, Applicants submit that the subject matter of the various groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a single invention and, therefore, merit examination in a single application. Therefore, it is improper to require that the subject matter of the above-enumerated groups be prosecuted in separate patent applications.

Second, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. This is especially true with regard to Groups II and III, which are all classified in class 435. Indeed, the common classification shared by these groups contradicts the statement on page 3 of the instant Office Action that the inventions “have acquired a separate status in the art because of their recognized divergent subject matter *and separate classification* ...”

Furthermore, as the M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (7th ed., July 1998).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden. Applicants submit that the search and examination of the various groups, especially Groups II and III, will have substantial overlap, and Applicants submit that no serious burden will result from searching and examining both groups in the same application.

Accordingly, in the interests of cost savings to both Applicants and the Patent and Trademark Office, Applicants propose that claims 1-42 be searched and examined in the instant application, and therefore respectfully request reconsideration and withdrawal of the restriction requirement. However, page 3 of the instant Office Action indicates that Applicants must make an election of the invention group to be examined notwithstanding the foregoing traversal of the restriction requirement. Therefore, Applicants hereby elect, with the above traverse, Group I, claims 1-14. For the Examiner's convenience, claims 1-14 are set forth in Appendix A attached hereto.

Sequence Rules

In addition, page 3 of the Office Action indicates that the instant application fails to comply with the requirements of 37 C.F.R. §§1.821-1.825 for the reason(s) set forth in the Notice to Comply With Requirements For Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosures. Applicants invite the Examiner's attention to the Response to the Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures filed on even date herewith to BOX SEQUENCE. For the Examiner's convenience, copies of the response and supporting documentation as filed are enclosed.

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at (617) 227-7400.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

A handwritten signature in cursive script, reading "Peter C. Lauro". The signature is written in dark ink and is positioned over the printed name of the signatory.

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